

**AMENDMENT TO THE DRAWING(S)**

Fig. 3 has been amended. The attached sheet of formal drawings replaces the original sheet including Fig. 3.

### **REMARKS/ARGUMENTS**

Applicant responds to the Office Action of April 18, 2006. A petition for extension of time (2 months) is enclosed.

The Office Action dated April 18, 2006 has been carefully considered. Claims 1-32 are pending in the present application with claims 1, 29 and 32 being in independent form. By the present Amendment, claims 1, 3, 5, 7, 8, 15, 17, 24 and 29 have been amended to further clarify the features of the present application. One sheet of replacement drawings is attached hereto including an amended Fig. 3. The specification has been amended to amend the title as requested by the Examiner.

The Examiner has objected the drawings since element 20 in Fig. 3 is labeled differently in Fig. 4. The Examiner notes that Fig. 4 refers to two frame elements 20a and 20b whereas, Fig. 3 refers to both elements as 20a. A sheet of replacement drawings including an amended Fig. 3 is submitted herewith wherein Fig. 3 has been amended to replace the reference numeral "20a" on the left side of the figure with the reference numeral --20b--.

Accordingly, it is respectfully submitted that the objection to the drawings be reconsidered and withdrawn.

With regard to the specification, the Examiner contends that the title is not descriptive. As noted above, the specification has been amended herein to amend the title. It is believed that the new title provides a better description of the invention.

The Examiner has rejected claims 5, 6, 17 and 18 under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement. Reconsideration of this rejection is respectfully requested. Claims 6 and 18 have been cancelled.

With regard to claim 5, the Examiner contends that the claim 5 states that the extended portion has a slope inclined an axis of the sheath and that this slope is not apparent from the drawings or described in the specification. By the present Amendment, claim 5 has been amended to specify that "the extended portion has a slope inclined with respect to an axis of the sheath." The slope of the extended portion 115a of the sheath 5 is clearly inclined, as illustrated in Fig. 12, for example.

With regard to claim 17, the same has been amended.

Accordingly, it is respectfully requested that the rejection of claims 5, 6, 17 and 18 under 35 U.S.C. §112, first paragraph, be reconsidered and withdrawn.

Claims 1, 3, 7, 8, 15, 16 and 24 have apparently been rejected under 35 U.S.C. §112, second paragraph, as allegedly failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. Applicant notes that while the Office Action only specifically rejects claim 1 under 35 U.S.C. §112, second paragraph, it is presumed that the formal errors pointed out in paragraphs 12-17 at page 4 of the Office Action are similarly presented as grounds for rejecting the remaining claims under 35 U.S.C. §112. Reconsideration of this rejection is respectfully requested.

With regard to claim 1, the Examiner claims that the phrase “an elongate member which has distal and proximal ends, and which is located in the distal end of the elongate member” is unclear. By the present Amendment, claim 1 has been amended to specify that the elongate member “is located on the distal end of the base member.”

With regard to claim 3, the Examiner contends that there is insufficient antecedent basis for the term “elongate portion.” Claim 3 has been amended to change the phrase “elongate portion” to “--elongate member--.”

With regard to claim 7, the Examiner contends that there is insufficient antecedent basis for the terms “the sheath,” “the insertion section” and “the biomedical tissue.” Similarly, with regard to claims 8, the Examiner contends that there is insufficient antecedent basis for the terms “the insertion section,” “the treatment section” and “the sheath.” It is believed that claims 7 and 8, as amended herein, correct these errors.

With regard to claim 15, the Examiner contends that there is insufficient antecedent basis for the terms “first driving member” and “the sheath.” In addition, with regard to claim 16, the Examiner contends that there is insufficient antecedent basis for the term “first driving member.” It is believed that the amendments made to claim 15 herein address these issues.

Finally, with regard to claim 24, the Examiner contends that there is insufficient antecedent basis for the term “the pivot.” Claim 24 has been amended hereby in order to correct this error.

Claims 1, 4-11, 23, 24 and 32 have been rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 6,063,103 to Hashiguchi. Reconsideration of this rejection is respectfully requested.

The Examiner contends that Hashiguchi discloses all of the limitations of claim 1 of the present application. Applicants respectfully disagree.

The surgical instrument recited in claim 1 of the present application features an extended portion 115a provided at the distal end of the elongate member (sheath 5) (see FIG. 13). The provision of the extended portion is intended to protect the proximal end of the end effector, and restrict rotation of the support (81). Claim 1 concerns itself with only the distal end portion of the surgical instrument. Independent claim 23, on the other hand, is directed to the entire structure of the surgery instrument including the feature taught in claim 1.

Independent claim 29 teaches provision of a notch, not the extended portion, at the distal end of the sheath (see FIG. 30). It teaches substantially the same structure as claim 1, in different expressions from those of claim 1.

Hashiguchi, as understood by Applicants, relates to endoscope forceps with a forceps section 1, an insertion section 2 and an operating section 3. The forceps include first and second jaws 4, 5 and opening/closing mechanism 6. The insertion section includes a tubular sheath 7 covered with insulating tube 29. The operating section includes a handle 9 with a stationary handle and a pivoting handle 9b and a connecting member 10 as an operating force transmitting member which connects operating rod 8 to pivoting handle 9b.

Hashiguchi, however, fails to disclose a surgical instrument including an end effector, “a support that supports the end effector” and “a base member which pivotally supports the support,” as required by claim 1 of the present application. While the jaws 4,5 of the forceps pivot relative to each other, at pivots 12 and 13, Hashiguchi does not disclose a support that supports the jaws and that is itself pivotally supported by a base member.

Further, Hashiguchi fails to disclose a surgical instrument including “an extended portion which is disposed in the distal end of the elongate member to be extended with respect to the base member located in the distal end of the elongate member, “as recited in claim 1 of the present application. In Hashiguchi, the sheath 7 does not include an extended portion on the

distal end of the elongate member. As can be seen in Fig. 1 of Hashiguchi, for example, the sheath does not extend with respect to the alleged support 14.

Accordingly, it is respectfully submitted that claim 1, and the claims depending therefrom, are patentable over the cited art for at least the reasons described above.

Similarly, with regard to claim 32, Hashiguchi fails to disclose a surgical instrument including “a sheath which covers an outer periphery of the insertion section, and a distal end, the distal end of the sheath having an area extended along an axis of the sheath more than other portions.” As noted above, the sheath 7 of Hashiguchi does not include an area that extends along the axis of the sheath more than other portions.

Accordingly, it is respectfully submitted that claim 32 is patentable over the cited art for at least the reasons discussed above.

Claims 12-14, 19-22 and 25-31 have been rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent 5,827,323 to Klieman et al. Reconsideration of this rejection is respectfully requested.

Independent claim 29, as amended herein, relates to a surgical instrument including an insertion section which has distal and proximal ends, and a sheath, the sheath including a notch which is partially notched on a distal end, a treatment section connected to the distal end of the insertion section to treat a biomedical tissue, and an operation section operated by an operator, the operation section being connected to the proximal end of the insertion section and operated by the operator to generate an operation force, which is transmitted through the insertion section to the treatment section.

Klieman et al., as understood by Applicant, relates to an endoscopic surgical tool with manual controls with a tubular barrel 10 with a handle 2 at its proximal end and an end effector 3 at its distal end. The end effector is preferably made of two blades 40,44 attached to the barrel by a pin 48 such that they are independently pivotable. The handle 2 includes controls for manipulating end effector 3.

Klieman et al. fails to disclose a surgical instrument including an end effector, “a support that supports the end effector” and “a base member which pivotally supports the support,” as required by claim 1 of the present application.

Accordingly, it is respectfully submitted that claim 29, and the claims depending therefrom, including claims 30-31, are patentable over the cited art for at least the reasons mentioned above.

Accordingly, it is respectfully submitted that claim 1, and the claims depending therefrom, including claims 12-14, 19-22 and 25-28, are patentable over the cited art for at least the reasons noted above.

Claims 17-18 have been rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 6,066,151 to Miyawaki et al. Reconsideration of this rejection is respectfully requested.

The Examiner contends that Miyawaki et al. discloses the elements of claims 17-18. Applicants respectfully disagree.

Claims 17-18 depend from claim 1. Miyawaki et al. does not disclose a surgical instrument including an end effector, “a support that supports the end effector” and “a base member which pivotally supports the support,” as required by claim 1 of the present application

Accordingly, it is respectfully submitted that claim 1, and the claims depending therefrom, including claims 17-18, are patentable over the cited art for at least the reasons described above.

Claims 15-16 have been rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent No. 6,659,178 to Miyawaki et al. (hereinafter “Miyawaki II”)

The Examiner contends that Miyawaki II discloses a coagulation apparatus with an end effector (305, 313), a support(286,300), a base member (303), an elongate member (231) and an extended portion (203) making reference to Figs. 22a and 28a. Applicants respectfully disagree.

As can be seen in Fig. 22a, for example, the jaw retaining member 300 does appear to support jaw 305. However, Miyawaki II does not disclose “a support that supports the end effector” and “a base member which pivotally supports the support,” as required by claim 1 of the present application. While the jaw 305 is pivotally supported on the jaw retaining member 300, the jaw retaining member 300 itself is not pivotally supported.

Accordingly, it is respectfully submitted that claim 1, and the claims depending therefrom, including claims 15-16 are patentable over the cited art for at least the reasons described above.

Claim 14, has been rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Klieman et al. and Hashiguchi et al. Reconsideration of this rejection is respectfully requested.

Claim 14 depends from claim 1. As noted above it is believed that claim 1 is patentable over both Klieman et al. and Hashiguchi. Further it is respectfully submitted that claim 1 is patentable over the combination Klieman et al. and Hashiguchi since both Klieman et al. and Hashiguchi fail to disclose the patentable features of claim 1 as described above.

Accordingly it is respectfully submitted that claim 1, and the claims depending therefrom, including claim 14, are patentable over the cited art for at least the reasons described above.

In light of the remarks and amendments made herein, it is respectfully submitted that all of the pending claims are patentable over the cited art and are in condition for allowance.

Favorable reconsideration is respectfully requested.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on: September 18, 2006

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Name of applicant, assignee or  
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September 18, 2006

Date of Signature

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Respectfully submitted,

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